



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,013	02/26/2004	Masaki Oomori	D-1580	6734

7590 11/01/2007
HAUPTMAN KANESAKA BERNER PATENT AGENTS, LLP
Suite 310
1700 Diagonal Road
Alexandria, VA 22314

EXAMINER

MORRISON, THOMAS A.

ART UNIT	PAPER NUMBER
----------	--------------

3653

MAIL DATE	DELIVERY MODE
-----------	---------------

11/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/786,013	OOMORI ET AL.
	Examiner	Art Unit
	Thomas A. Morrison	3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 August 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-6 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4 and 14-21 is/are rejected.
- 7) Claim(s) 5 and 6 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 16 August 2007 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2/26/2004.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. Applicant's information disclosure statement filed 2/26/2004 has been considered and an initialed Form 1449 is included with this Office Action.

Drawings

2. The drawings were received on 8/16/2007. These drawings are accepted.

Claim Objections

3. Claims 5 and 6 are objected to because of the following informalities: (1) in claim 5, "drive means connected to the transporting means for driving the same and capable of rotating in forward and reverse directions" should be -- drive means connected to the transporting means for driving the same and capable of rotating in forward and reverse directions, --. In other words, a comma should be added after this limitation to separate this limitation from the next limitation in claim 5. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-4 and 14-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the sheet **feeding** stacker" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim 15 depends from claim 14, which ultimately depends from claim 1. Claim 1 recites, "a sheet discharge stacker disposed above the sheet feed stacker". After this, lines 9-10 of claim 15 recite, "said sheet discharge stacker being disposed above the sheet feed stacker". Thus, claim 15 includes the same limitation that was already set forth in claim 1. As such, this repeated limitation should be further clarified or canceled.

Claim 21 recites the limitation "said **feeding** means" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4, 14-17 and 21, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,060,923 (Takimoto et al.).

Regarding claim 1, Figs. 1-16 show a document feeder (Fig. 3) to be disposed above a platen (8) of an image reading apparatus (Fig. 2), comprising:

a sheet feed stacker (including 24 and 26) disposed above the platen (8) for stacking an original,

a sheet discharge stacker (including 36) disposed above the sheet feed stacker (including 24 and 26),

a transporting guide (130) having one side (e.g., bottom side) for communicating with the sheet feeding stacker (including 24 and 26) and the sheet discharge stacker (including 36), and the other side (top side),

transporting means (including 182 and 186) disposed above the platen (8) adjacent to the other side (top side) of the transporting guide (130), the transporting means (including 182 and 186) transporting the original from the sheet feed stacker (including 24 and 26) to a predetermined position on the platen (8) through the transporting guide (130) and transporting the original on the platen (8) to the sheet discharge stacker (including 36) through the transporting guide (130),

drive means (including 290) connected to the transporting means (including 182 and 186) for driving the same and capable of rotating in forward and reverse directions. See e.g., column 21, line 58 to column 22, line 11 for explanation of the reversible drive means (including 290).

Regarding claim 4, as best understood, Figs. 1-3 show feeder means (including 44) disposed adjacent to the sheet feed stacker (including 24) for feeding the original from the sheet feed stacker (including 24) to the transporting means (including 182 and 186), and interconnecting means (i.e., whatever frame structure(s) interconnect sheet feed stacker (including 24) and sheet discharge stacker (including 36)) disposed between the sheet feed stacker (including 24) and the sheet discharge stacker

(including 36), the sheet feed stacker (including 24) and the sheet discharge stacker (including 36) being pivotally arranged (Fig. 2) to enlarge a rear space between the sheet feed stacker (including 24) and the sheet discharge stacker (including 36) at a side adjacent to the transporting guide (130) so that when the sheet discharge stacker (including 136) is rotated, the interconnecting means is actuated to push a forward end of the sheet feed stacker in a direction away from the feeder means. Regarding the recitation, "said sheet feed stacker and said sheet discharge stacker being pivotally arranged to enlarge a rear space between the sheet feed stacker and the sheet discharge stacker at a side adjacent to the transporting guide **so that when the sheet discharge stacker is rotated, the interconnecting means is actuated to push a forward end of the sheet feed stacker in a direction away from the feeder means**", the bolded portion of this recitation does not define this claim over the prior art apparatus of Takimoto et al. in view of MPEP, section 2114. Specifically, MPEP, section 2114 states that, "While features of an apparatus may be recited either structurally or functionally, claims< directed to >an< apparatus must be distinguished from the prior art in terms of structure rather than function." See MPEP, section 2114.

Alternatively, it is also noted that in the recitation, "said sheet feed stacker and said sheet discharge stacker being pivotally arranged to enlarge a rear space between the sheet feed stacker and the sheet discharge stacker at a side adjacent to the transporting guide so that when the sheet discharge stacker is rotated, the interconnecting means is actuated to push a forward end of the sheet feed stacker in a direction away from the feeder means", the bolded portion of this

recitation is a conditional limitation that need not ever occur. Since the bolded portion of this recitation contains conditional limitations that need not ever occur, this bolded portion of the recitation does not define claim 4 over the prior art apparatus of Takimoto et al. For example, if the sheet discharge stacker is not rotated at all, this conditional limitation does not occur. As such, it is the examiner's position that all of the features of claim 4 are met by Takimoto et al.

Regarding claim 14, Figs. 1-16 show an image reading apparatus (Fig. 2) comprising:

a platen (8) for placing an original thereon,
photoelectric converting means (see e.g., column 6, lines 7-22) disposed adjacent to the platen (8) for reading the original on the platen (8). The elements of the document feeder that is disposed on the platen (8) are set forth in the rejection of claim 1 above.

Regarding claim 15, Figs. 1-16 show a device frame (16) for covering an entire portion of the platen (8), a transporting case frame (132) attached to the device frame (16) for covering a part of the platen (8) and supporting the transporting means (including 182 and 186), and a light-shielding cover member (52 or 308) attached to the device frame (16) at a portion other than a portion where the transporting means (including 182 and 186) is attached for blocking light from the platen (8), the sheet feed stacker (including 24) being disposed above the light-shielding cover member (52 or

308), the sheet discharge stacker (including 36) being disposed above the sheet feed stacker (including 24).

Regarding claim 16, as best understood, Figs. 1-16 show feeder means (including 44) disposed adjacent to the sheet feed stacker (including 24) for feeding the original from the sheet feed stacker (including 24) to the transporting means (including 182 and 186), and interconnecting means (i.e., whatever frame structure(s) interconnect sheet feed stacker (including 24) and sheet discharge stacker (including 36)) disposed between the sheet feed stacker (including 24) and the sheet discharge stacker (including 36), the sheet feed stacker (including 24) and the sheet discharge stacker (including 36) being pivotally arranged (Fig. 2) to enlarge a rear space between the sheet feed stacker (including 24) and the sheet discharge stacker (including 36) at a side adjacent to the transport guide (130) so that when the sheet discharge stacker (including 36) is rotated, the interconnecting means is actuated to push a forward end of the sheet feed stacker in a direction away from the feeder means. Regarding the recitation, "said sheet feed stacker and said sheet discharge stacker being pivotally arranged to enlarge a rear space between the sheet feed stacker and the sheet discharge stacker at a side adjacent to the transport guide **so that when the sheet discharge stacker is rotated, the interconnecting means is actuated to push a forward end of the sheet feed stacker in a direction away from the feeder means**", the bolded portion of this recitation does not define claim 16 over the prior art apparatus of Takimoto et al. in view of MPEP, section 2114. Specifically, MPEP, section 2114 states that, "While features of an apparatus may be recited either structurally or

functionally, claims< directed to >an< apparatus must be distinguished from the prior art in terms of structure rather than function.” See MPEP, section 2114.

Alternatively, it is also noted that in the recitation, “said sheet feed stacker and said sheet discharge stacker being pivotally arranged to enlarge a rear space between the sheet feed stacker and the sheet discharge stacker at a side adjacent to the transport guide so that **when the sheet discharge stacker is rotated, the interconnecting means is actuated to push a forward end of the sheet feed stacker in a direction away from the feeder means**”, the bolded portion of this recitation is a conditional limitation that need not ever occur. Since the bolded portion of this recitation contains conditional limitations that need not ever occur, this bolded portion of the recitation does not define claim 16 over the prior art apparatus of Takimoto et al. For example, if the sheet discharge stacker is not rotated at all, this conditional limitation does not occur. As such, it is the examiner’s position that all of the features of claim 16 are met by Takimoto et al.

Regarding the rejection of claim 17, different elements of U.S. Patent No. 5,060,923 (Takimoto et al.) are relied upon than those relied upon in the rejection of claim 1 above. Thus, all of the elements of claims 1, 14, 16 and 17 are included in the rejection of claim 17 below. With regard to claim 17, Figs. 1-16 show a document feeder (Fig. 3) to be disposed above a platen (8) of an image reading apparatus (Fig. 2), comprising:

a sheet feed stacker (including 22 and 24) disposed above the platen (8) for stacking an original,

a sheet discharge stacker (including 36) disposed above the sheet feed stacker (including 22 and 24),

a transporting guide (130) having one side (e.g., bottom side) for communicating with the sheet feeding stacker (including 22 and 24) and the sheet discharge stacker (including 36), and the other side (top side),

transporting means (including 182 and 186) disposed above the platen (8) adjacent to the other side (top side) of the transporting guide (130), the transporting means (including 182 and 186) transporting the original from the sheet feed stacker (including 22 and 24) to a predetermined position on the platen (8) through the transporting guide (130) and transporting the original on the platen (8) to the sheet discharge stacker (including 36) through the transporting guide (130),

drive means (including 290) connected to the transporting means (including 182 and 186) for driving the same and capable of rotating in forward and reverse directions. See e.g., column 21, line 58 to column 22, line 11 for explanation of the reversible drive means (including 290).

Also, Figs. 1-16 show a platen (8) for placing an original thereon,

photoelectric converting means (see e.g., column 6, lines 7-22) disposed adjacent to the platen (8) for reading the original on the platen (8). Moreover, the document feeder (Fig. 3) is disposed on the platen (8).

Moreover, Figs. 1-16 show feeder means (including 44) disposed adjacent to the sheet feed stacker (including 22 and 24) for feeding the original from the sheet feed stacker (including 22 and 24) to the transporting means (including 182 and 186), and interconnecting means (i.e., whatever frame structure(s) interconnect sheet feed stacker (including 22 and 24) and sheet discharge stacker (including 36)) disposed between the sheet feed stacker (including 22 and 24) and the sheet discharge stacker (including 36), the sheet feed stacker (including 22 and 24) and the sheet discharge stacker (including 36) being pivotally arranged (Fig. 2) to enlarge a rear space between the sheet feed stacker (including 22 and 24) and the sheet discharge stacker (including 36) at a side adjacent to the transporting guide (130) so that when the sheet discharge stacker (including 36) is rotated, the interconnecting means is actuated to push a forward end of the sheet feed stacker in a direction away from the feeder means. Regarding the recitation, “said sheet feed stacker and said sheet discharge stacker being pivotally arranged to enlarge a rear space between the sheet feed stacker and the sheet discharge stacker at a side adjacent to the transporting guide **so that when the sheet discharge stacker is rotated, the interconnecting means is actuated to push a forward end of the sheet feed stacker in a direction away from the feeder means**”, the bolded portion of this recitation does not define claim 17 over the prior art apparatus of Takimoto et al. in view of MPEP, section 2114. Specifically, MPEP, section 2114

states that, "While features of an apparatus may be recited either structurally or functionally, claims< directed to >an< apparatus must be distinguished from the prior art in terms of structure rather than function." See MPEP, section 2114.

Alternatively, it is noted that in the recitation, "said sheet feed stacker and said sheet discharge stacker being pivotally arranged to enlarge a rear space between the sheet feed stacker and the sheet discharge stacker at a side adjacent to the transporting guide so that **when the sheet discharge stacker is rotated, the interconnecting means is actuated to push a forward end of the sheet feed stacker in a direction away from the feeder means**", the bolded portion of this recitation is a conditional limitation that need not ever occur. Since the bolded portion of this recitation contains conditional limitations that need not ever occur, this bolded portion of the recitation does not define claim 17 over the prior art apparatus of Takimoto et al. For example, if the sheet discharge stacker is not rotated at all, this conditional limitation does not occur.

In addition, Figs. 1-16 show that the feeder means (including 44) includes a feed roller (122 or 60) for drawing out an uppermost original on the sheet feed stacker (including 22 and 24) and a rotating member (including 124 and 126), and the sheet feed stacker (including 22 and 24) includes urging means (125) for pressing the forward end thereof against the rotating member (including 124 and 126). Thus, all of the limitations of claim 17 are met.

Regarding claim 21, Figs. 1-3 show that the feeding means (including 44) is disposed above the sheet feed stacker (including 24 and 26).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 3 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,060,923 (Takimoto et al.) as applied to claims 1 and 16 above, and further in view of U.S. Patent No. 4,412,738 (Ahern et al.) or U.S. Patent No. 4,345,751 (Holzhauser). The Takimoto et al. patent discloses most of the features of claims 2 and 18. With regard to claim 2, Figs. 1-16 of Takimoto et al. disclose a pair of pulleys (393 and 382), an endless belt (394) placed between the pulleys (393 and 382), and a tension roller (374) for restricting a distance between the endless belt (394) and the platen (8), the transporting guide (130) being arranged for guiding the original to a part of the endless belt (394) located between one of the pulleys (e.g., 393) and the tension roller (374). With regard to claim 18, Figs. 1-16 of Takimoto et al. disclose that the transporting means (including 182 and 186) includes an endless belt (394) placed along the platen (8) for transferring the sheet. However, Takimoto et al. does not disclose vacuum means, as claimed.

The Ahern et al. and Holzhauser patents both disclose that it is well known to provide a document feeder to be disposed above a platen (e.g., reference numeral 12 in

both Ahern et al. and Holzhauser) with vacuum means (See Abstracts in both Ahern et al. and Holzhauser) for the purpose of effectively tacking a document page to moving guides (32 in Ahern, and 82 in Holzhauser) for movement to the platen (12). See e.g., Abstracts in both Ahern et al. and Holzhauser). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the apparatus of Takimoto et al. with vacuum means for the purpose of effectively tacking a document page to the moving guide (130) of Takimoto et al. for movement to the platen (8) of Takimoto et al., as taught by the Abstracts of both Ahern et al. and Holzhauser. Thus, all of the limitations of claims 2 and 18 are met.

Regarding claim 3, as best understood, the transporting guide (130) has, at the other side, a forward end portion composed of an elastic film member contacting the platen (8). Moreover, providing vacuum means on the apparatus of Takamoto et al., in a manner as taught by Ahern et al. and Holzhauser, will result in the elastic film member of Takimoto et al. being located adjacent to a chamber of the vacuum means. Thus, all of the limitations of claim 3 are also met

Response to Arguments

7. Applicant's arguments filed 8/16/2007 have been fully considered but they are not persuasive. Applicant argues

In paragraph 5 of the Action, it was held that "Figs. 1-16 show a document feeder ... comprising: a sheet feed stacker (including 24 and 26)...., transporting means (including 130)...., a sheet discharge stacker (including 36)...., a transporting guide (including 22 and 474)"

In the above explanation, a base portion 22 and a guide member 474 separated from each other are deemed as a transporting guide. However, the base portion 22 is formed adjacent to an extension 24 as the sheet feed stacker, while the guide member 474 is spaced from the base portion

Art Unit: 3653

22 and is located at document discharging-reversing means. The base portion 22 and the guide member 474 are completely spaced apart from each other and operate entirely differently or separately. Thus, the base portion 22 and the guide member 474 are completely separate members, and can not constitute one transporting guide, corresponding to the invention.

Especially, the transporting means in claim 1 transports the original from the sheet feed stacker to a predetermined position on the platen through the transporting guide and transports the original on the platen to the sheet discharge stacker through the same transporting guide. In Takimoto et al., the sheet from the sheet feed stacker can not pass the same portion twice when it is ejected to the sheet discharge stacker.

The explanation in the Action is not correct, and Takimoto et al. does not disclose or even suggest the transporting guide of the invention, through which the sheet from the sheet feed stacker is supplied onto the platen and the sheet on the platen is discharged to the discharge stacker.

In response, claim 1, as now amended, recites "a transporting guide having one side for communicating with the sheet feeding stacker and the sheet discharge stacker, and the other side, transporting means disposed above the platen adjacent to the other side of the transporting guide, the transporting means transporting the original from the sheet feed stacker to a predetermined position on the platen through the transporting guide and transporting the original on the platen to the sheet discharge stacker through the transporting guide". As explained above in the rejection of claim 1, element 130 meets the transport guide limitation as now set forth in claim 1, and at least elements 182 and 186 meet the transporting means limitations now set forth in claim 1. More specifically, element 130 acts as a transporting guide having one side (e.g., bottom side) for communicating with the sheet feeding stacker (including 24 and 26) and the sheet discharge stacker (including 36), and the other side (top side). Also, at least elements 182 and 186 act as transporting means disposed above the platen (8) adjacent to the other side (top side) of the transporting guide (130). Such transporting

means (including 182 and 186) transports the original from the sheet feed stacker (including 24 and 26) to a predetermined position on the platen (8) through the transporting guide (130) by moving the transport guide (130), and also transports the original on the platen (8) to the sheet discharge stacker (including 36) through the transporting guide (130) via the moving of the transport guide (130). Thus, all of the limitations of claim 1, as now amended, are met by Takimoto et al.

Allowable Subject Matter

8. Claims 5 and 6 would be allowable if amended to overcome the objection outlined above. Claims 19 and 20 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Morrison whose telephone number is (571) 272-7221. The examiner can normally be reached on M-F, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

10/26/2007

PATRICK MACKEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600